REMARKS / ARGUMENTS

Formal Matters

The Examiner has required acknowledgement of the telephonic restriction election. The Examiner has also indicated that claims 1-6 and 9-19 are pending and that said claims are considered for examination.

Applicants hereby acknowledge election of claims 1-6 and 9-19 for examination. Applicants note that claim 7 and 8 should be considered pending. Claims 7 and 8 have been withdrawn from consideration, but are still pending. Furthermore, it is noted that the Examiner has not set forth the applicability of rejoinder in the instant case. The Examiner has restricted the inventions based on pharmaceutical compositions and processes of making said compositions, *i.e.* the Examiner has restricted the inventions based on product and process claims. Applicants believe rejoinder practice is applicable to the product (Group I) and process (Group II) claims (MPEP § 821.04).

For the reasons set forth above, Applicants request that the Examiner consider claim 7 and 8 pending and acknowledge rejoinder practice is applicable and will be followed if the product (Group I) claims are found allowable.

Title

The Examiner has required a new title "that is clearly indicative of the invention to which the claims are directed."

Applicants respectfully request that the objections to the title in light of the amendment to the title be withdrawn. Support for the new title can be found in the specification on page 1, lines 10-11.

Claim Objection

The Examiner has objected to the claims on the grounds that CCI-779 "should include the proper name".

Applicants respectfully request that the claim objection predicated on the "proper name" of CCI-779 be withdrawn.

The claims have been amended to recite the "proper name" for CCI-779. However, for the record it is noted that CCI-779 is a term of the art. Accordingly, a person of ordinary skill in the art would be well aware that CCI-779 refers to rapamycin 42-ester with 3-hydroxy-2-(hydroxymethyl)-2-methylpropionic acid, as indicated on page 1, lines 10-11, of the specification. It is further noted that noted that Applicant can be her own lexicographer (MPEP § 2111.01 III).

In light of the amendments to the claims, the Examiner is respectfully requested to withdrawn the claim objection based on the "proper name" of CCI-779.

35 USC § 102(e)

> *The Examiner has rejected claims 1-6, 9-12, and 15-17 as being anticipated by Zhu et al. (US Patent Publication No. 2002/00055518 A1). The Examiner states that Zhu et al. teach pegylated hydroxyesters of rapamycin. Finally, the Examiner alleges that Zhu et al. teach a pharmaceutical composition comprising granulated CCI-779, a water soluble polymer (PVP), a surfactant (sodium lauryl sulfate), an antioxidant (calcium carbonate), and a pH modifying agent (sodium citrate).*
>
> *The Examiner alleges that claim 10-12 and 15-17 are not patentable by way of a different process of making a known product.*

Applicants respectfully request that the rejection under 35 USC § 102(e) be withdrawn.

Applicants have amended the claims to recite specific ranges for the antioxidant in the oral compositions claimed (support, for example, can be found in the specification on page 4, lines 8-11). The ranges now recite that the antioxidant is from 0.001% to 3% (wt/wt). Therefore, Zhu *et al.* do not meet all of the limitations of the claims.

It is noted that the Examiner has indicated that calcium carbonate is an antioxidant. Calcium carbonate is taught by Zhu *et al.*, but it is not claimed in the instant pharmaceutical compositions. It is further noted that Zhu *et al.* teach pegylated hydroxyesters of rapamycin whereas the instant invention teaches that CCI-779 exhibits poor aqueous solubility and aqueous instability and that solubility and instability problems

can unexpectedly be overcome by the pharmaceutical compositions claimed (see, for example, page 2, lines 30-33, to page 3, lines 1-13, and page 7, lines 12-20).

In regard to the Examiner's reliance Zhu *et al.* where it is alleged that calcium carbonate acts as an antioxidant, Applicants respectfully request that the Examiner substantiate that calcium carbonate is an antioxidant since Zhu *et al.* teach it to be a "suspending or stabilizing agent" (¶ [0048]).

In regard to the Examiner's reliance on the assertion that a known product is not patentable because it was made by a different process, Applicants assert that the pharmaceutical compositions are not taught by Zhu *et al.* Therefore any rejections predicated on the process not conferring patentability are inapplicable since Zhu *et al.* do not teach the pharmaceutical compositions.

For the reasons set forth above, the Examiner is respectfully requested to reconsider and withdraw the rejection under 35 USC 102(e).

35 USC § 103(a)

> *The Examiner has rejected claims 13-14 and 18-19 as being unpatentable over Zhu et al. in view of Rubino et al. (US Patent Application No. 2004/0167152 A1) and further in view of Madhavi et al. (Food Antioxidants: Technological, Toxicological, and Health Perspectives, Decker, 1996). The Examiner alleges the instant invention would be obvious because the composition taught by Zhu et al. can further comprise the antioxidants BHA or BHT since Rubino et al. teach compositions comprising CCI-779 and BHA or BHT. The Examiner alleges that motivation to combine the documents can be derived from Rubino et al. because compositions comprising BHA or BHT and CCI-779 are taught. The Examiner further alleges that motivation can be derived from Madhavi et al. because "the antioxidants BHA and BHT . . . are commonly used and exhibit excellent absorption, metabolism and excretion."*
>
> *The Examiner alleges that claims 13-14, which depend from claim 10, and claims 18-19, which depend from claim 15, are not patentable by way of a different process of making a known product.*

Applicants respectfully request that the rejection under 35 USC § 103(a) be withdrawn.

For the reasons set forth above, Zhu *et al.* do not teach the pharmaceutical compositions claimed. Therefore, rejections relied on by Zhu *et al.* do not render the

instant invention obvious. It is noted that Rubino *et al.* was published on August 26, 2004, which is well after the priority date and filing date of the instant invention, which is September 17, 2002 and September 15, 2003, respectively. 35 USC § 103(a) specifically states that the invention has to be "obvious at the time the invention was made", which makes any reliance on Rubino *et al.* contrary to this statute.

Applicants also note that the basis for the 102(e) rejection, and the primary reference of this 103(a) rejection, Zhu *et al.*, US Patent Publication No. 2002/00055518 A1, falls under the provisions of 35 USC § 103(c) and will not preclude patentability under this section since at time the invention was made the claimed inventions were commonly owned. Accordingly, Zhu *et al.* qualifies only as prior art under 35 USC § 102(e). It is noted that Wyeth, the assignee of instant invention, acquired American Home Products, the assignee of the Zhu *et al.* publication, prior to the making of the instant invention.

In regard to the Examiner's reliance on Madhavi *et al.*, the mere alleged fact that "the antioxidants BHA and BHT . . . are commonly used and exhibit excellent absorption, metabolism, and excretion" does not render motivation to combine either of these compounds in pharmaceutical compositions comprising CCI-779. The pharmacokinetic profile does not, without more, provide adequate motivation for combining either BHA or BHT in pharmaceutical compositions comprising CCI-779. Madhavi *et al.* teach that BHA and BHT are extensively used in the food industry (page 277, ¶ 2). Madhavi *et al.* do not teach or provide motivation to combine BHA or BHT in a pharmaceutical composition comprising CCI-779.

In regard to the Examiner's reliance on the assertion that a known product is not patentable because it was made by a different process, Applicants assert that the pharmaceutical compositions are not obvious over Zhu *et al.* in view of Rubino *et al.* and further in view of Madhavi *et al.* for the reasons set forth above. Therefore any rejections predicated on the process not conferring patentability are inapplicable since the pharmaceutical compositions of the instant invention are not obvious.

For the reasons set forth above, the Examiner is respectfully requested to reconsider and withdraw the rejection under 35 USC 103(a).

In view of the above amendments and these remarks, Applicants respectfully request that the Examiner reconsider and withdraw all outstanding objections and rejections and permit the above pending claims to pass to issue in due course.

The Director is hereby authorized to charge any deficiency in any fees due with the filing of this paper or credit any overpayment in any fees to our Deposit Account Number 08-3040.

Respectfully submitted,

HOWSON AND HOWSON
Attorneys for Applicant

By 

Cathy A. Rodroff
Registration No. 33,980
501 Office Center Drive
Suite 210
Fort Washington, PA 19034
Phone: (215) 540-9200
Fax: (215) 540-5818